REMARKS

Claims 1-41 are unchanged and remain pending in the present application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Grainger (U.S. Pub. No. 2002/0161733) ("Grainger 1") in view of "Declaration of Use of Mark in Commerce under § 8 (15 U.S.C. § 1058)" ("TLTIA") in view of Grainger (U.S. Pub. No. 2002/0091542) ("Grainger 2") and further in view of Fields (U.S. Pub. No. 2002/0069154) ("Fields"). This rejection is respectfully traversed.

Grainger 1

Applicant previously submitted that Grainger 1 is related to annuities only and to patents only. It is true that at paragraph [0024], Grainger states: "The present invention is useful for managing other forms of intellectual property including trade marks." However, from then on in the document there is no further mention or teaching of a system for trade marks.

Further, section [0035] of Grainger 1 does state: "Co-ordinating, tracking and providing payment options for all financial aspects of the patent process including Patent Office fees, practitioner fees and service provider fees." However, these are not clear and unmistakable directions as to how to calculate costs of a registered trade mark application comprising:

Receiving input data describing at least one territory for said registered trade mark applications;

receiving input data describing a number of classes of goods/services for said registered trade mark applications;

storing component cost data relating to a plurality of component costs of said registered trade mark application in a plurality of territories; and

calculating substantially in real time said calculated cost data relating to a cost of said registered trade mark application from said stored component cost data and said data describing at least one territory and said data describing a number of classes of goods/services;

wherein said calculated cost data represents a real time running total cost for said registered trade mark application, said calculated cost data changed substantially in real time on modifying said data describing a number of goods/services of said registered trade mark application.

Although Grainger 1 is not limited to patents, and is not limited to annuities, as the Examiner points out, there is still a gap of imagination required by the inventor to reach the claimed invention with Grainger 1. In particular, steps [ii], [iii], [iv] and [v] are not explicitly disclosed or suggested by Grainger 1.

In response to the Examiner's comment in the final paragraph of page 10 of the Office Action, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art (*Fine, A37 F.2d 1071,5 USPQ 2d 1596 Fed. Cir. 1988, and in Jones, 958 F.2d 347, 21 USPQ 2d 1941 Fed. Cir. 1992*).

Applicant respectfully submits that although Grainger 1 mentions trade marks in the document, there are no statements in Grainger 1 which would motivate the person

of ordinary skill in the art to combine that teaching with the other references (Grainger 2, Fields, TLTIA.

Considering the technical features of claim 1, Grainger 1 does not disclose the following features:

- Receiving input data describing the number of classes of goods/services for said registered trade mark applications.
- Calculating substantially in real time said calculated cost data relating to a cost of said registered trade mark application from said stored component cost data and said data describing at least one territory and said data describing a number of classes of goods/services.
- Wherein said calculated cost data represents a real time running total cost for said registered trade mark application, said calculated cost data changing substantially in real time on modifying said data describing a number of goods/services of said registered trade mark application.

Grainger 1 does disclose:

- At [0125] payment of annuity and maintenance fees (in relation to a trade mark, [0024]).
- Grainger 1 allows an in-house attorney or patent manager to approve a fixed payment cost sent by an external counsel or an external attorney, but does not provide for any cost calculation or modification of the cost at the client end of the system. It is a simple system where a cost is presented at the client computer and a person can select to pay or not to pay that cost (see [0126] Grainger 1).

Grainger 2

Grainger 2 discloses payment of annuity fees for trade marks [0011]. Grainger 2 discloses a method and system for calculating patent term extensions [0018]. A data processing system tracks all data necessary for calculating patent term adjustments and performs a term adjustment calculation and notifies a user of a calculated adjustment. At [0035], the disclosed calculation is a date calculation for paying a fee, rather than a calculation of the fee (cost) itself. In Figure 5 and [0047] of Grainger 2, there is disclosed a list of separate countries and annuity costs, and there is a calculation facility for calculating the cost of renewing a portfolio of IP rights such as trade marks. However, at the level of the individual trade mark, there is no facility for exploring the variations in cost depending upon the number of classes of goods and services.

Combined Prior Art

Combining Grainger 2 with TLTIA and Fields would not lead to a more efficient method of calculating costs data in relation to a registered trade mark application because Grainger 2 is a cumbersome system directed at an all-encompassing intellectual property IT solution. It does not address the problem of efficient cost calculation of registered trade mark applications on-line without the use of human intervention with real time modification of the goods/services.

Further, a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. It is important to identify a reason which would have prompted a person of ordinary skill in

the relevant field to combine the elements of Grainger, Fields, and TLTIA as suggested by the Examiner. No such suggestion has been forwarded by the Examiner, and Applicant respectfully submits that in fact, the inventor did not, and would not, have combined the elements of Grainger 2, Fields and TLTIA in the manner as claimed in the presently amended claims.

In determining whether the subject matter of the present application is obvious or not, what matters is the objective reach of the claim, and in this respect Grainger 2, Fields and TLTIA do not forward any suggestion of a known problem in calculating cost data relating to the cost of a registered trade mark application where the goods/services can be varied, nor an obvious solution to that problem.

Further, it is important to guard against slipping into the use of hindsight when retrospectively reading the prior art, Grainger 2, Fields and TLTIA, in light of the teaching and claimed invention of the present application. Applicant considers it by no means obvious from the combined prior art to try the solution as set out in the presently pending claims. Neither the teaching of Grainger, Fields, nor TLTIA, either alone or in combination, illustrates or specifically sets out the problem of calculating cost data for a registered trade mark application, giving a real time running total cost, where the current input details of number of goods/services can be amended as part of the real time on-going process.

Additionally, a combination of Grainger, Fields and TLTIA would lead to a system which has a different purpose from the presently claimed invention. Combining Fields and TLTIA with Grainger 2 would change the primary purpose of Grainger 2 and change the principal operation of that reference. Some of the prior art documents disclose

giving a cost for a renewal of a trade mark. In general, renewals of trade marks are paid after registration, while the present claimed invention claims a trade mark application (i.e., before registration). A combination of the prior art would change the principal purpose and operation of the presently claimed invention, and the skilled person would in general not seek to combine those prior art documents in order to achieve the principal object of the present invention.

A combination of Grainger, Fields and TLTIA would be unsatisfactory for the intended purpose of the invention, namely, to give a real time calculated cost of a registered trade mark application. Neither Grainger, Fields nor TLTIA disclose interactively changing the cost in response to different selections of goods and services in real time. A combination of the mentioned prior art would be unsatisfactory for the intended purpose of the presently claimed invention.

Further, combining Fields, TLTIA with Grainger 2 would lead to an unpredictable result for Grainger 2. Specifically, Grainger 2 relies on estimation of cost (see [0047]), which is not the same as giving detailed costs (i.e., a quotation) which is good in real time. The data included in the Grainger 2 database is historical data, and rapidly becomes out of date as foreign associate fees change by the second due to exchange rates, and as official fees change with inflation, or predictably assigned changes to associate attorney rates. In contrast, the claimed invention gives a mathematically and mechanically calculated cost based upon up-to-date data, and, therefore, is less in the manner of an estimate than an accurate calculated cost.

Applicant respectfully asserts that a combination of the art cited does not lead to a combination of features as set out in the pending claims. For the reasons set forth

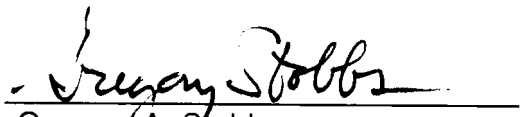
above, Applicant maintains the language of the pending claims and disagrees with the Examiner's analysis of obviousness which Applicant regards as giving undue weight to ex-post facto reasoning and hindsight. Therefore, it is respectfully submitted that these claims define patentable subject matter and reconsideration and withdrawal of the rejections is requested.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: December 2, 2008

By: 

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